

### **REMARKS**

Claims 11 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Staten (U.S. Patent No. 1,097,824) and further in view of Ahmad (US 3,866,652), Panaroni (U.S. Patent No. 5,254,045) and Yunan (U.S. Patent No. 3,894,593). Withdrawal of the rejection and allowance of the application are respectfully requested in view of the comments below.

Staten is directed to a tubeless tire filled with a core of relatively large (i.e., "appreciable size") solid tire particles of and adhesive material wherein the tire particles and adhesive material are assembled in a mold, vulcanized into a complete tire innard to which the tire casing is "forced into place under considerable pressure and by means of suitable clamps." (see Staten col. 3, lines 34-36). Staten does not disclose or suggest a tire having a core substantially filled with a mixture of core bits and a liquid virgin polyurethane, an outer casing, an exposed rim and a valve fixed to said rim.

Panaroni, Yunan, and Ahmad do not remedy the defects of Staten or suggest the claimed invention. Panaroni discloses a dessicated rubber embedded into a polyurethane which is then molded into a tire. Panaroni does not teach or suggest a tire substantially filled with a solution of liquid virgin polyurethane and core bits prior to curing or vulcanization. Yunan discloses a structure made from dumping shredded polyurethane foam and pneumatic fibers wetted with latex, into an open mold. Ahmad discloses a tire filled with a mixture of liquid and hollow spheres.

One skilled in the art would not have combined these references 60-80 because none of these references suggest such a combination. In making this combination, hindsight has been improperly used to take the invention's disclosure as a blueprint for piecing together references without evidence of such a suggestion, teaching or motivation to combine them. *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999); *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 547 (Fed. Cir. 1985); *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight). While the evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved (See, *Pro-Mold & Tool Co. v. Great*

*Lakes Plastics, Inc.*, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996)), it does not diminish the requirement that there be actual clear and particular evidence for the combination. *C.R. Bard, Inc. v. M3 Sys., Inc.*, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). The office action provides nothing more than broad conclusory statements regarding the teaching of multiple references, which is legally insufficient evidence of a motivation to combine. *McElmurry v. Arkansas Power & Light Co.*, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Additionally, even if combined, the combination of Panaroni, Yunan, and Ahmad with Staten does not arrive at the claimed invention because none of these references teach a tire substantially filled with a solution of core bits and liquid virgin polyurethane prior to curing or vulcanization. Accordingly, withdrawal of this rejection is respectfully requested.

#### CONCLUSION


In view of the above remarks, withdrawal of the rejection and issuance of a Notice of Allowance is requested.

Respectfully submitted,

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